

Application Serial No. 09/930,717
Attorney Docket No. 00-065

REMARKS

- Claims 1-27 were pending in the present application
- Claims 1-27 stand rejected

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims 1, 3-15, and 18-30 will be pending
- Claims 2 and 16-17 will be cancelled
- Claims 1, 11, and 24 will be amended
- Claims 28-30 will be added
- Claims 1, 11, and 24 will be the only independent claims

Telephone Interview

Applicants would like to thank the Examiner for the helpful telephone conversation held on December 11, 2002 with Applicants' representative.

The Examiner and Applicants' representative agreed that the cited Acres and Pettit references, alone or in combination, do not teach or suggest any feature generally directed to terminating an automated session. The Examiner and Applicants' representative also agreed that the amendment (provided herein) of independent Claims 1, 11, and 24 to provide for a feature of terminating the automated session if the limiting criterion has occurred would obviate the Section 103(a) rejection.

Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Specification Amendments

The Abstract has been amended to overcome the Examiner's objection. Also, a minor and obvious and typographical error has been corrected.

Claim Amendments

1. Claims 2 and 16 have been cancelled without prejudice

Claims 2 and 16 have been cancelled without prejudice. Applicants reserve the right to and plan to pursue the subject matter of Claims 2 and 16 in a continuing application.

2. Claim 17 has been cancelled

Claim 17 has been cancelled to overcome the Examiner's objection under 37 CFR 1.75(c) to Claim 22, as Claim 17 is an exact duplicate of Claim 22. Applicants respectfully request that the Examiner withdraw the objection to Claim 22.

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3. Claims 1, 11, and 24 have been amended

Each of Claims 1, 11, and 24 has been amended to provide for a feature of *terminating the automated session if the limiting criterion has occurred*, as discussed with the Examiner during the Telephone Interview.

4. New Claims 28-30 have been added

New Claims 28-30 are dependent from amended independent Claim 11.

Section 103(a) Rejection

Claims 1, 3-15, and 17-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,741,183 issued to Acres, et al. ("Acres"), in view of U.S. Patent No. 5,551,692 issued to Pettit, et al. ("Pettit"). Applicants respectfully traverse the Examiner's Section 103(a) rejection.

Claim 17 has been cancelled; accordingly, the Section 103(a) rejection of Claim 17 is moot.

With respect to amended independent Claims 1, 11, and 24, as discussed with the Examiner during the Telephone Interview, Applicants respectfully submit that neither Acres nor Pettit, alone or in combination, provide for any feature generally directed to terminating an automated session if a limiting criterion has occurred. Accordingly, Applicants respectfully submit that none of the cited references provide for any of the following features:

- *determining a limiting criterion based on the at least one parameter*
- *determining if the limiting criterion has occurred*
- *terminating the automated session if the limiting criterion has occurred*

as now recited in each of amended independent Claims 1, 11, and 24.

Claims 3-10 are dependent from independent Claim 1. Claims 12-15 and 18-23 are dependent from independent Claim 11. Claims 25-27 are dependent from independent Claim 24. For at least the reasons stated herein, Applicants respectfully submit that Claims 1, 3-15, and 18-27 contain allowable subject matter.

Newly-Added Claims 28-30 Contain Allowable Subject Matter

Applicants respectfully submit that newly-added Claims 28-30 are patentable over the cited prior art of record.

New Claims 28-30 are dependent from independent Claim 11. For at least the reasons stated herein with respect to independent Claim 11, Applicants respectfully submit that new Claims 28-30 contain allowable subject matter.

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Double Patenting Rejection

Claims 2 and 16 were "rejected under the judicially created doctrine of obviousness-type double patenting" as being unpatentable over Claims 1-35 of U.S. Patent No. 6,012,983 ("the '983 patent") and Claims 1-21 of U.S. Patent No. 6,244,957 B1 ("the '957 patent"). Applicants respectfully traverse this double patenting rejection.

Claims 2 and 16 have been cancelled; accordingly, the obviousness-type double patenting rejection of Claims 2 and 16 is moot.

However, as discussed with the Examiner, independent Claims 1 and 11 have been amended herein to recite features of now-cancelled Claims 2 and 16, respectively. Accordingly, Applicants respectfully traverse any implication of the Examiner's obviousness-type double patenting rejection with respect to independent Claims 1 and 11.

The Examiner asserts: "it would have been obvious...to make the game of U.S. Patent No. 6012983 or U.S. Patent No. 6244957 B1 a lottery game in order to increase the variety offered to players, thereby increasing the appeal of the game." Applicants respectfully traverse this assertion. Applicants respectfully submit that in light of this brief statement, the Examiner has failed to establish a *prima facie* case of obviousness-type double patenting.

According to MPEP § 804, in determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent?. Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804.

Based on the Examiner's brief statement, it is Applicants' understanding that the Examiner is asserting the following:

- (i) the only difference between either independent Claim 1 or independent Claim 11 and any one of the 56 specified patent claims is that the patent claims are directed to "the game" and the pending claims are directed to "a lottery game;"
- (ii) it would have been obvious to modify any one of the 56 patent claims to provide for "a lottery game in order to increase the variety offered to players, thereby increasing the appeal of the game;"
- (iii) independent Claim 1 is an obvious variation of any one of the 56 patent claims; and
- (iv) independent Claim 11 is an obvious variation of any one of the 56 patent claims.

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If Applicants' understanding is not correct, Applicants respectfully request that the Examiner clarify: (i) all of the differences between each of independent Claims 1 and 11 and any particular patent claim that the Examiner asserts is in conflict, and (ii) the reason(s) why one of ordinary skill in the art would conclude that any of independent Claims 1 and 11 is an obvious variation of the respective invention defined by any of the conflicting patent claims. See MPEP § 804.

The sole asserted difference

If Applicants' understanding as to the sole asserted difference between independent Claim 1 or Claim 11 and any one of the 56 patent claims is correct, Applicants respectfully traverse this assertion. For example, each of independent Claims 1, 13, and 27 of the '983 patent and independent Claim 1 of the '957 patent recites a feature of "a gaming device"; neither independent Claim 1 nor independent Claim 11 recites such a feature.

In other examples, (i) independent Claim 1 recites a feature of *determining at least one lottery outcome* and (ii) independent Claim 11 recites a feature of *determining at least one instant lottery game*. None of independent Claims 1, 13, and 27 of the '983 patent or independent Claim 1 of the '957 patent recites a feature generally directed to either (i) determining an outcome or (ii) determining a game, much less either (i) determining a lottery outcome or (ii) determining an instant lottery game.

Accordingly, Applicants respectfully traverse the Examiner's assertion that the only difference between either independent Claim 1 or Claim 11 and any one of the 56 patent claims is that the patent claims are directed to "the game" and the pending claims are directed to "a lottery game."

Applicants respectfully request that the Examiner undergo the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103. Specifically, Applicants respectfully request that the Examiner clarify all of the differences between each of independent Claims 1 and 11 and any particular patent claim that the Examiner asserts is in conflict: "a claim in the patent compared to a claim in the application." See MPEP § 804. Applicants will be best able to assist the Examiner in examination of the pending claims if the Examiner specifies which limitations of a pending claim are taught or suggested by a particular issued claim, and which limitations of a pending claim are not taught or suggested by a particular issued claim.

Official Notice

The Examiner asserts: "it would have been obvious...to make the game...a lottery game in order to increase the variety offered to players, thereby increasing the appeal of the game." Because the Examiner did not provide a reference supporting this asserted motivation in the prior art, Applicants assume that the Examiner intended to take Official Notice of what would have been well known to one of ordinary skill in the art at the time of invention.

Applicants respectfully traverse this asserted motivation as an improper factual finding, because it is a mere conclusion without any support in the record. Applicants also respectfully request that this use of Official Notice be supported by a reference, so that Applicants may better assist the Examiner in examination of the claims. Per MPEP 2144.03, the burden is on the

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Examiner to provide a reference once such a request has been made. Specifically, a reference must be provided to show the scope and content of the prior art.

No motivation for asserted "obvious variation"

Applicants respectfully submit that the Examiner has not stated a suggestion or motivation, either in any one of the 56 issued claims or in the knowledge generally available to one of ordinary skill in the art, to modify the subject matter of any one of the 56 issued claims cited references to provide for the asserted sole difference ("the lottery game").

It is also not clear to Applicants what the Examiner means by "the game" of the issued claims. For example, the Examiner appears to suggest that substituting "a lottery game" for "the game" would increase the appeal of "the game." It is not clear how substituting one game for another would increase variety or the appeal of "the game."

The Examiner merely asserts that it would have been obvious "to increase the variety offered to players" without providing a reasoning why such a modification to any one of the 56 issued claims would have been obvious. The Examiner is effectively stating that offering more games to players is always desirable, without providing a rationale as to why one of ordinary skill in the art would find it obvious, in light of the subject matter claimed in a particular one of the 56 issued claims, to provide for "a lottery game" in particular.

Further, as described above, various differences between independent Claims 1 and 11 and some of the 56 issued claims have not been addressed by the Examiner, nor has the Examiner provided a rationale as to why any such differences are obvious variations of any one of the 56 issued claims.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness-type double patenting for any of independent Claims 1 or 11.

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Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.


Petition for Extension of Time to Respond

Applicants hereby petition for a two-month extension of time with which to respond to the Office Action. Please charge \$205.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

February 24, 2003
Date



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